

Remarks:

Reconsideration of the application, as amended herein, is respectfully requested.

Claims 22 - 46 are presently pending in the application.

Claims 22 - 24, 28 - 32, 43, 45 and 46 have been amended.

Claims 1 - 21 were previously canceled by preliminary amendment.

On page 2 of the above-identified Office Action, claims 22 - 46 were rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. More particularly, it was alleged in the Office Action that "the contents" in claim 22 was undefined. Claim 22 has been amended to recite "a content", to even more clearly define the referenced "content". Independent claim 46 has been similarly amended.

On page 3 of the Office Action, claim 32 was rejected as allegedly not having antecedent basis for "the second telecommunication terminal". Applicants have amended claim 32 to address the concern raised with regard to that claim.

On page 2 of the Office Action, it was alleged that claim 22 was indefinite because the term "not having access" was alleged to be ambiguous as a negative claim limitation. On page 3 of the Office Action claim 46 was rejected "for the

same reason as 22". Applicants respectfully traverse the rejections of claims 22 - 46 under 35 U.S.C. § 112, second paragraph.

First, a negative claim limitation is not, per se, an indefinite claim limitation. M.P.E.P. § 2173.05(i) states, in part:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. § 112, second paragraph. [emphasis added by Applicants]

As such, the patent laws hold that so long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. § 112, second paragraph. The limitations of Applicants' claims 22 and 46 are clearly set forth definitely, and thus, comply with the requirements of 35 U.S.C. § 112, second paragraph. For example, Applicants' claims 22 and 46 recite, among other limitations:

..., the switching component not having access to a content of the encrypted user data object due to the encryption; [emphasis added by Applicants]

As such, Applicants claims require, among other things, a switching component not having access to a content of the

encrypted user data object due to the encryption. The foregoing language of the claims does not specify what the invention does not do, but rather, describes a property of the switching component (i.e., the claim limitation does not define an "action"). Thus, Applicants' claims unambiguously define the properties of the switching component of the invention (i.e., not having accessed to a content of the encrypted data) and further defines the reason for this property (i.e., due to encryption).

In fact, Applicants' claims specify a unique and distinct property of the relationship between the switching component and the user data object by defining whether the switching component has access to (i.e., can decrypt) the content of the user data object, or if it has no such access. A person of ordinary skill in this art, reading claims 22 and 46, would be left with no ambiguity as to the meaning to those claims. Rather the scope of claims 22 and 46 is uniquely determined. Thus, the objected to limitation of Applicants' claims are believed to fully define the metes and bounds of the invention to a person of ordinary skill in this art, and thus, meet the requirements of 35 U.S.C. § 112, second paragraph.

Further, on page 3 of the Office Action, the terms "useful" and "suitable were objected to as being a "literal"

translation of the foreign priority document. In particular, Applicants note that the German word "Nutzdatenobjekt" used in the parent application was translated as "useful data object" in the instant application, whereas the better translation of "Nutzdatenobjekt" would be "user data object" or "payload". This meaning is supported by the specification of the instant application, when read in context. See, for example, page 18 of the instant application, lines 12 - 23, which stated:

1. An encrypted useful data object, i.e. a useful data object NDO provided in a DRM container object CO, is transmitted by the sender-side MMS switching unit SMV to the recipient-side MMS switching unit EMV (cf. α). It is assumed here that the encrypted useful data object has previously been sent for example by a further telecommunications terminal assigned to the sender-side MMS switching unit SMV (refer, for example, to the telecommunications terminal TG1 of FIG. 1) by means of a multimedia message for forwarding to the mobile telephone TG2. **However, a plurality of (encrypted or DRM-protected) useful data objects may also be contained in a multimedia message of this type.** [emphasis added by Applicants]

It can be seen from the foregoing that the referenced "useful data object" NDO is a payload / user data object provided in a DRM container object CO. See also, for example, Fig. 3 of the instant application, illustrating a DRM container object CO containing a payload /user data object NDO.

As such, Applicants have amended the specification and claims of the instant application to correct the translation of

"Nutzdatenobject" from "useful data object" to the more proper "user data object". The terms "user data" and "user data object" are technical terms, the meanings of which would be known to a person of ordinary skill in this art. It is believed that these amendments address the concerns raised under 35 U.S.C. § 112, second paragraph, on page 3 of the Office Action.

Further, Applicants believe that the definition of the term "suitable", as used in the claims, would also be very clear to a person of ordinary skill in this art. M.P.E.P. § 2173.02 speaks directly to the question of when the term "suitable" is clear in the claims. In particular, M.P.E.P. § 2173.02 states, in part:

For example, a claim recites "**a suitable liquid** such as the filtrate of the contaminated liquid to be filtered and solids of a filtering agent such as perlite, cellulose powder, etc." The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ *per se* rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as *per se* rules. The test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). **If one skilled in the art is able to ascertain in the example above, the meaning of the terms "suitable liquid" and "solids of a filtering agent" in light of the specification, 35 U.S.C. 112, second paragraph, is satisfied.** If upon review of the claim as a whole in light of the

specification, the examiner determines that a rejection under 35 U.S.C. 112, second paragraph, is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase "such as" in the claim, the examiner may make such a suggestion to the applicant. If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue.

As such, in addressing the use of the word "suitable" in a claim, M.P.E.P. § 2173.02 held that, "[i]f one skilled in the art is able to ascertain in the example above, the meaning of the terms "suitable liquid" and "solids of a filtering agent" in light of the specification, 35 U.S.C. 112, second paragraph, is satisfied". Thus, speaking directly on point, M.P.E.P. § 2173.02 holds that, if a person of ordinary skill in this art were able to ascertain the meaning of the term "suitable" from the specification of the instant application, then 35 U.S.C. § 112, second paragraph is satisfied. Applicants believe that a person skilled in this art would be able to ascertain the meaning of the word "suitable", as used in the present claims, from the specification.

In particular, the term "suitable" is not used in the present claims in a context-free manner. Rather, the objected to term "suitable" is used in the context of a "user data object ... suitable for processing" by a telecommunications terminal. See, for example, claim 22. The meaning of the terms "suitable" and "suitability", as used in the context of the

claims, are clearly defined in the specification of the instant application, for example, on page 6 of the instant application, lines 16 - 22, which state:

This is all the more critical if the user of the receiving terminal device downloads a rights object matching the content object for a charge onto his or her mobile terminal device and discovers only after the downloading and invoicing associated therewith **that the contents are not suitable for the terminal device or cannot be used or can be used only with restrictions.** [emphasis added by Applicants]

See also, for example, page 10 of the instant application, lines 10 - 15, which state:

5. The switching component (recipient-side MMS switching unit) inquires of a data provisioning component of the content provider via the corresponding reference (URL) in the DRM container whether the encrypted content **or the encrypted user data object is suitable for the receiving terminal device, i.e. can also be used on the latter.** [emphasis added by Applicants]

As can be seen from the foregoing, the specification of the instant application teaches a person skilled in this art that the user data object is suitable if it can be used by the terminal without restrictions. Clearly, a person skilled in this art, reading the specification of the instant application, would be able to ascertain with clarity and precision the meaning of the word "suitable", as used in the context of the claims. As such, pursuant to M.P.E.P. § 2173.02, the use of the term "suitable" in the instant claims

satisfies the requirements of 35 U.S.C. § 112, second paragraph.

Notwithstanding the foregoing, in an effort to further prosecution of the instant application, Applicants have amended the claims to use the term "usable" and/or "usability" instead of "suitable" or "suitability", where appropriate. These amendments are supported by the specification of the instant application, for example, on page 6 of the instant application, lines 16 - 22 and page 10 of the instant application, lines 10 - 15.

Further, the term "encrypted" data object is also objected to on page 3 for allegedly not having support for where the encrypted object originates. Applicants respectfully traverse this rejection. The origin of the encrypted user data object is not relevant for the operation of the invention. As noted in the Office Action, a person skilled in this art knows that a transmitted object has a source. The user data object of the instant invention can originate, for example, from a second terminal, from a server, from a second data provisioning component, just to name a few of the possible sources. The present invention is directed to the claimed system and method wherein a user data object is available at the switching component to be transmitted to the

telecommunications terminal. Thus, Applicants believe that the encrypted data object of the instant claims also satisfies the requirements of 35 U.S.C. § 112, second paragraph.

For the foregoing reasons, among others, claims 22 - 46 meet the requirements of 35 U.S.C. § 112, second paragraph.

On page 5 of the Office Action, claims 22 - 46 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over PCT Application Publication Number WO 02/4314 to Mostafa ("MOSTAFA") in view of U. S. Patent Application Publication No. 2002/0077986 to Kobata ("KOBATA").

Applicants respectfully traverse the above rejections.

More particularly, as discussed above, Applicants' claim 22 recites, among other limitations:

in a switching component of a telecommunications network, **providing an encrypted user data object to be transmitted to the first telecommunications terminal and a reference for checking a usability of the encrypted user data object by the first telecommunications terminal**, the switching component not having access to a content of the encrypted user data object due to the encryption; [emphasis added by Applicants]

Similarly, Applicants' independent claim 46 recites, among other limitations:

said switching component configured to provide an encrypted user data object to be transmitted to the at least one first telecommunications terminal **and a reference for checking a usability of the encrypted user data object by the at least one first telecommunications terminal**, the switching component not having access to a content of the encrypted user data object due to the encryption; [emphasis added by Applicants]

As such, Applicants' claims require, among other limitations, a switching component providing an encrypted user data object to be transmitted to a first telecommunications terminal **and a reference for checking the usability of the encrypted user data object by the first telecommunications terminal**, wherein the switching component does not have access to the content of the encrypted user data object (i.e., payload) due to the encryption. The above limitations of Applicants' claims do not appear to have been given the proper patentable weight in the Office Action, due to their alleged ambiguity. As noted above, Applicants' claims are not ambiguous, but rather, are clear and precise, satisfying the requirements of 35 U.S.C. § 112, second paragraph. As such, all limitations of Applicants' claims must, **necessarily**, be found in the prior art for those references to render Applicants' claims obvious in the manner alleged in the Office Action.

However, the prior art references cited in the Office Action do not teach or suggest all of the limitations of Applicants'

claims. For example, neither the **MOSTAFA** reference, nor the **KOBATA** reference, teach or suggest, among other limitations of Applicants' claims, providing an encrypted user data object and a reference for checking the usability of the encrypted user data object by the first telecommunications terminal, as required by Applicants' claims. This failure of **MOSTAFA** was even acknowledged in paragraph 1.2 of the Written Opinion of the International Search Authority.

Pages 6 - 7 of the Office Action alleged, in part:

Mostafa is silent in explicitly disclosing that the useful data object is encrypted. Kobata teaches a similar message relay system in which the useful data object art encrypted and include digital rights assigned to them (0072). As one of ordinary skill in the art would know, encryption is essential if one wants to protect the content from unauthorized users. Encrypting the useful data objects of Mostafa would ensure users could not intercept them and thereby cheat the system of not having to subscribe to the objects. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt the objects of Mostafa because it would increase the security of the system.

Further, page 4 of the Office Action alleged, in part:

Kobata teaches the use of header and other appendages for encrypted file to orchestrate their transmission. The idea of encrypted data objects and encapsulating them with header and reference data is extremely well known in the art. A switch does not need to decrypt the data object in order to process it. Kobata teaches adding these important references are added [sic] explicitly for this reason. Therefore the combination of Mostafa and Kobata clearly can check

for suitability of an encrypted data object without decryption.

Applicants respectfully disagree with the allegations made in the Office Action.

More particularly, contrary to the allegations made on page 4 of the Office Action, the use of headers and other appendages for encrypted files "to orchestrate their transmission", as disclosed in **KOBATA**, does not teach or suggest, among other limitations of Applicants' claims, **a reference for checking the usability of the encrypted user data object by the destination telecommunications terminal**, as required by Applicants' claims. Rather, the headers and "other appendages" for encrypted files of **KOBATA**, would be used to route a packet to its destination terminal (i.e., as specified by the header and "other appendages") regardless of whether or not the destination terminal could actually **use** the data object. Nothing in **KOBATA** teaches or suggests that the headers and "other appendages" are a reference for checking whether the receiving terminal can actually **use** the data object, once decrypted. Thus, the **KOBATA** reference cannot cure this deficiency of the **MOSTAFA** reference.

Further, Applicants respectfully disagree with the allegation made on page 4 of the Office Action that "... the combination of

Mostafa and Kobata clearly **can check for suitability of an encrypted data object** without decryption". The **KOBATA** and **MOSTAFA** references do not teach or suggest, among other things, "checking for suitability" or, as applied to the presently amended claims, "checking for usability by" the first terminal.

In the instant invention, the reference for checking the usability of the encrypted data object by the first terminal is sent because the capabilities of the first terminal are not known at the time of providing the encrypted data object/reference. In Applicants' claimed invention, the "reference for checking" allows the data provisioning component to perform a check of whether or not the data object is appropriately usable by the destination terminal. These features of Applicants' claims are simply not taught or suggested in the **KOBATA** and **MOSTAFA** references.

Further, in contrast to Applicants' claimed invention, the **MOSTAFA** and **KOBATA** referenced do not teach or suggest, among other limitations of Applicants' claims, **that the switching component does not have access to the contents of the encrypted user data object due to encryption**. As discussed above, this feature of Applicants' claims is not indefinite, but rather, clearly and precisely informs a person skilled in

this art of the metes and bounds of the claim. As such, this limitation of Applicants' claims must be given patentable weight.

Further still, the **MOSTAFA** and **KOBATA** references do not teach or suggest, among other limitations of Applicants' claims, that the switching component transmits a request to a data provisioning component for checking the "usability" of the data object by the terminal. Similarly, in contrast to the claimed invention, **MOSTAFA** and **KOBATA** do not teach or suggest that this "request" is transmitted to the data provisioning component together with a determined profile, as required by Applicants' claims. The failure of **MOSTAFA** to teach this limitation was additionally acknowledged by the International Search Authority. See, for example, paragraph 1.2 of the Written Opinion of the International Search Authority.

Page 6 of the Office Action analogized an MMS server of **KOBATA** to Applicants' claimed data provisioning component and an MMS relay B of **MOSTAFA** with Applicants' claimed switching component. Applicants respectfully disagree.

There is no teaching or suggestion in the **MOSTAFA** reference that the MMS server of **MOSTAFA** receives a request from the MMS

relay B of **MOSTAFA** to perform a check of the usability of the data object by the particular first terminal, as required by Applicants' claims. Accordingly, there is no teaching, suggestion or motivation provided in **MOSTAFA** to send such a "request" to the MMS server of **MOSTAFA** with a determined profile of the terminal capabilities, as further required by Applicants' claims.

The **MOSTAFA** and **KOBATA** references also do not teach or suggest, among other limitations, a data provisioning component that transmits information relating to the result of a "usability" check to the switching component, as also required by Applicants' claims. In particular, the portions of **MOSTAFA** cited on page 6 of the Office Action for allegedly disclosing this feature of Applicants' claims, do not. Rather, the passages of **MOSTAFA** cited on page 6 of the Office Action are silent with regard to any relevant communication between the MMS server of **MOSTAFA** (analogized in the Office Action to Applicants' claimed "data provisioning component") and the MMS relay B of **MOSTAFA** (analogized in the Office Action to Applicants' claimed "switching component"). The **KOBATA** reference does not cure the above discussed deficiencies of the **MOSTAFA** reference.

For the foregoing reasons, among others, Applicants' claims are believed to be patentable over the **MOSTAFA** and **KOBATA** references, whether taken alone or in combination.

It is accordingly believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claims 22 - 46. Claims 22 - 46 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 22.

In view of the foregoing, reconsideration and allowance of claims 22 - 46 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

The instant response is being filed simultaneously with a Request for Continued Examination and its associated fee. Additionally, please consider the present as a petition for a one (1) month extension of time, and please provide a one (1) month extension of time, to and including, July 6, 2009, to respond to the present Office Action.

The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of \$130.00 in accordance with Section 1.17 is enclosed herewith.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Steiner LLP, No. 12-1099.

Respectfully submitted,

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For Applicants

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